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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,454	07/18/2003	Satoru Hamada	043873-5005-02	1128
9629	7590	06/08/2006		
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER ANGEBRANNDT, MARTIN J	
			ART UNIT	PAPER NUMBER
			1756	
DATE MAILED: 06/08/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,454

Applicant(s)

HAMADA, SATORU

Examiner

Martin J. Angebrannndt

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The response of the applicant has been read and given careful consideration. Rejections of the previous office action are withdrawn based upon the arguments and amendments to the claims. As the claims differ and the rejections are new, any response the arguments is moot.
2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 32-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "the reflective element" lacks antecedent basis. The examiner suggests introducing it as part of the master hologram to obviate the rejection made under 35 USC 103 below.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fabbiani et al. '366 combined with Ueda et '598, in view of Sudo et al. '581 and Khait '760.

Fabbiani et al. '366 teaches with respect to figure 1(b), the formation of a hologram which includes an image (7), barcoding (23) and a number (24) all recorded holographically. Figures 9(a) and 9(b) teach the use of implanted LCDs in optical cards which effects the appearance of a hologram coated on top of it, including the reflectance. (3/27-34).

Ueda et '598 teaches the recording of holographic images where the subject is a hologram (1/52-58) The substrate (subject backing) may be a reflecting mirror, colored glass, patterned or scattering plates (8/42-51). The use of photopolymeric holographic recording materials is disclosed (13/8+). Article 1 in figures is a holographic recording tape. The masking of the exposure is disclosed with respect to article 14 in figures 6a and 6b and consists of a masked UV exposure to inactivate portions of the medium and after the recording exposure a fixation exposure is used. (13/62-14/33). The simultaneous recording of multiple subjects is disclosed with respect to figures 18.

Sudo et al. '581 teaches the formation of holographic images according to the light transmitted by the LCD with respect to figures 2,5a and 5b-7. The ability to mask part of the holographic recording medium is disclosed as allowing optimum exposure for each area and increased freedom of design. (1/29-42)

Khait '760 teaches the use of selective LCD exposure to provide a serial number or the like to photosensitive materials. (7/26-46) The use of the LCD in various places is also disclosed. (8/29-55).

It would have been obvious to one skilled in the art to modify the process of Ueda et '598 to use the hologram with the LCD backing of Fabbiani et al. '366 based upon the disclosure that it affects the light transmitted and therefore the appearance of the hologram having the multiple images and use it with changes between exposures to record a serial number adjacent to the main holographic image based upon the previous use of LCDs to control the exposure area and the image produced within the art as evidenced by Sudo et al. '581, the previous use of LCDs to control the exposure of serial numbers as evidenced by Khait '760 and the desirability of forming serial numbers in final holograms as evidenced by Fabbiani et al. '366.

With respect to the issue of a reflective element not being taught adjacent to a master hologram, the examiner disagrees with the position of the applicant as the article taught by Fabbiani et al. '366 clearly teaches a LCD within a holographic article and in contact with the hologram (see text relating to figures 9a and 9b). Further, the Fabbiani et al. '366 teaches that the LCD affects the color of the hologram upon replay and that it is desirable to record serial numbers and the like in holograms. Khait '760 and Sudo et al. '581 teach the use of LCDs within the art to impress serial numbers, mask images and the like on photosensitive materials which the duplication means such as that of Ueda et '598 would be amenable to distinguishing between the serially produced images and clearly the use of holograms as the object is taught and the use of patterned and reflective backing is taught within Ueda et '598 and the article of Fabbiani et al. '366 clearly falls within these. The examiner notes that the direct contacting between the subject, which may be a hologram is clearly taught within Ueda et '598, but agrees with the position of the applicant that the reference itself does not teach every element. That is the reason that more than one reference is combined to form the rejection.

Currently, the rejection establishes the obviousness of the substitution of the card f figures 9a or 9b of Fabbiani et al. '366 where a hologram overlies the LCD element for the subject having a reflective backing taught in the process of Ueda et '598, which also teaches the use of holograms as the subjects. Clearly in Ueda et '598 a hologram incorporating both the subject and the reflective backing is formed at the same time. The citation of Sudo et al. '581 and Khait '76 are combined with the teachings of Fabbiani et al. '366 concerning the appearance of the hologram being changed due to the image/data displayed by the LCD to clearly establish that the use of LCD to record information in photosensitive materials is known in the art and that

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the differences in reflectivity effect a masking of the holographic image. The citation of Ueda et al. '598 is less concerned with the subsequent processing involving masking processes than the backing of the subject material. The rejection stands.

The claims could be placed in condition for allowance if the claims indicated that the reflective element was part of the master hologram and that the sub-hologram was in a different area of the hologram recording film from the main-hologram.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 32-43 are rejected on the ground of nonstatutory double patenting over claims 1-30 of U. S. Patent No. 6,613,481 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Claims 15-30 of the issued patent describe a process within the claims, including the

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exposure means and simultaneous recording of the main and sub holograms. Claim 9 specifically describes the recording or serial numbers.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ichikawa et al. JP 04-237086 teaches providing holograms with markings and in figure 1 shows successive holograms provided with the numbers 1 and 2.

JP 08-166758 teaches providing holograms with registration markings, which allow detection of the location of the adjacent hologram.

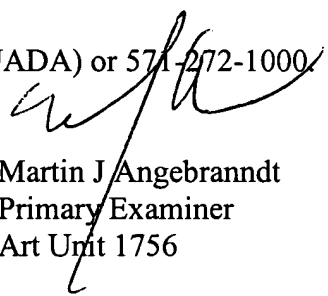
Kodama et al. '014 teach similar holograms, but differs in the scope of coverage sought.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin J. Angebrannndt whose telephone number is 571-272-1378. The examiner can normally be reached on Monday-Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Martin J. Angebranndt
Primary Examiner
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06/05/2006